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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,543	03/14/2005	Kazuaki Tanaka	Q86208	1403
23373	7590	11/05/2007	EXAMINER	
SUGHRUE MION, PLLC			MERCIER, MELISSA S	
2100 PENNSYLVANIA AVENUE, N.W.			ART UNIT	PAPER NUMBER
SUITE 800			1615	
WASHINGTON, DC 20037				

  

MAIL DATE	DELIVERY MODE
11/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/524,543	TANAKA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Melissa S. Mercier	1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 September 2007.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### Summary

Receipt of Applicants Remarks and Amended Claims filed on September 4, 2007 is acknowledged. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application. Claims 1-20 are pending in this application.

### ***Maintained Rejections***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-6, 15, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Murad et al. (US Patent 6,071,541).

Murad discloses a composition for the cleansing of skin to facilitate the prevention, treatment, and management of skin conditions (abstract). Example 2 discloses Canadian Willow herb Whole Extract (column 12, lines 23-24). The

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composition may further comprise an antibacterial agent (column 6, lines 14-15), moisturizers, anti-inflammatory agents, anti-oxidants, water and solvents (column 6, lines 52-57). Preferred moisturizers include sodium chloride (column 7, lines 27-28). Preferred anti-inflammatory include licorice extract (column 7, lines 41-52). Preferred anti-oxidants include vitamin C (column 7, lines 54-68).

Claims 1-2, 6-7, 16, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Vollhardt (US Patent 6,274,124).

Vollhardt discloses a composition suitable for application to the skin comprising at least one anti-oxidant such as green tea catchins, rosemary extract, ascorbic acid (vitamin C), at least one anti-inflammatory agent such as willow herb extract, arnica Montana extract (column 4, line 50- column 5, line 5), and 1,2-pentanediol (a diol with 5 carbons) (column3, lines 26-28).

Claims 1, 3-4, 6, 12, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Soler et al. (US Patent 6,113,926).

Soler discloses a cosmetic composition for topical application comprising plant extracts including willow herbs (abstract). The composition can further comprise demulcent extracts such as aloe, oat, and mallow, anti-free radicals, such as vitamin C, an anti-inflammatory (column 2, lines 47-68).

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Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannell et al. (US Patent 6,861,077).

Cannell discloses a cosmetic composition comprising willow herb extract (abstract). The composition may further comprise vegetable extracts including carrot extract (column 5, lines 30-44) and soybean extract (column 5, line 64), which applicant discloses as humectants.

#### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that the cited reference does not disclose the use of jojoba leaf or an extract thereof and therefore does not anticipate the claim. The examiner disagrees. The claim recites "a cosmetic containing willowherb and at least one selected from the group consisting of..."; therefore, it is the examiners position that jojoba is not required to be present in the cited reference in order to anticipate the claim.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-3, 7, 10-17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murad et al. (US Patent 6,071,541) in view of Vollhardt (US Patent 6,274,124) and Soller et al (US Patent 6,113,926).

The individual teachings of Murad, Vollhardt, and Soller are discussed above and applied in the same manner.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been

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individually taught in prior art. Therefore, since each of the references teach that plant extracts such as jojoba leaf, rosemary, sweet hydrangea leaf extract, carrot extract, brown algae extract, ect are effective ingredients in cosmetic compositions, it would have been obvious to combine these plants with the expectation that such a combination would be effective in skin care compositions. Thus, combining them flows logically from their having been individually taught in prior art.

Claims 2, 4, 6-7, 10-12, 16-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannell et al. (US Patent 6,861,077) in view of Vollhardt (US Patent 6,274,124) and Soller et al (US Patent 6,113,926).

The individual teachings of Cannell, Vollhardt, and Soller are discussed above and applied in the same manner.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that plant extracts such as jojoba leaf, rosemary, sweet hydrangea leaf extract, carrot extract, brown algae extract, ect are effective ingredients in cosmetic compositions, it would have been obvious to combine these plants with the expectation that such a

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combination would be effective in skin care compositions. Thus, combining them flows logically from their having been individually taught in prior art.

Claims 2, 7, 10-11, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soler et al. (US Patent 6,113,926) in view of Vollhardt (US Patent 6,274,124).

The teachings of Soler are discussed above and applied in the same manner.

Soler does not disclose the use of jojoba leaf extract or rosemary extract.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have expanded upon the teachings of Soler to include the additional extracts of Vollhardt.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that plant extracts, antioxidants, humectants, and anti-inflammatory are effective ingredients in compositions for treating skin, it would have been obvious to combine these plants with the expectation that such a combination would be effective in skin care compositions.

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Thus, combining them flows logically from their having been individually taught in prior art.

***Newly Applied Rejections***

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murad et al. (US Patent 6,071,541), Vollhardt (US Patent 6,274,124), Soler et al. (US Patent 6,113,926), or Cannell et al. (US Patent 6,861,077), in view of Becker et al. (US Patent 5,698, 206).

The individual teachings of Murad, Vollhardt, Solar and Cannell are discussed above and applied in the same manner.

Murad, Vollhardt, Solar and Cannell do not disclose the use of jojoba oil in their products.

Becker discloses a composition for the topical application to the skin comprising jojoba oil.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated the jojoba oil into the compositions of Murad, Vollhardt, Solar, or Cannell since jojoba oil is a well-known lubricant used in cosmetic formulations. Additionally, It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose

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in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that plant extracts, antioxidants, humectants, and anti-inflammatory are effective ingredients in compositions for treating skin, it would have been obvious to combine these plants with the expectation that such a combination would be effective in skin care compositions. Thus, combining them flows logically from their having been individually taught in prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSMercier

  
Gollamudi S. Kishore, PhD  
Primary Examiner  
Group 1600